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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,548	01/28/2002	Paul Wegner	9280-20001	3755

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BENASUTTI, P.A.
17294 BERMUDA VILLAGE DRIVE
BOCA RATON, FL 33487

EXAMINER	
JOYNES, ROBERT M	

ART UNIT	PAPER NUMBER
1615	

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/058,548	WEGNER, PAUL	
	Examiner	Art Unit	
	Robert M. Joynes	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-44* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/30/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-44 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for eliminating existing odors, does not reasonably provide enablement for preventing the production of new odors. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

1) the quantity of experimentation necessary,

2) the amount of direction or guidance provided,

3) the presence of absence of working examples,

4) the nature of the invention,

5) the state of the prior art,

6) the relative skill of those in the art

7) the predictability of the art, and

8) the breadth of the claims.

Applicant fails to set forth the criteria that define the prevention of the production of new odors in matter. Additionally, Applicant fails to provide information allowing the skilled artisan to ascertain these parameters without undue experimentation. In the instant case, only a limited number of composition examples are set forth that are recited to be used for many different situations, thereby failing to provide sufficient working examples of the prevention of future odors. It is noted that these examples are neither exhaustive, nor define the class of uses for the compositions required. The biological arts are unpredictable, requiring each embodiment to be individually assessed for physiological activity. The instant claims read on elimination of odors as well as the prevention of future odors, necessitating an exhaustive search for the embodiments suitable to practice the claimed invention. Applicants fail to provide information sufficient to practice the claimed invention, absent undue experimentation.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite that the oxide and nitrate composition is incorporated in *Portland* cement. It is unclear what Portland cement is

and how it differs from other forms of cement. It is also unclear as to whether or not the term is a trademark. Appropriate clarification or correction is suggested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-9, 18, 21-23, 27-31 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamaguchi et al. (JP 2000-005775 or application number 10-180899). Hamaguchi teaches a mixture of hydrogen peroxide or sodium carbonate and a nitrate ion to remove odor (See Abstract and machine translation provided). The nitrate can be a sodium, calcium, potassium or ammonium nitrate (See Claim 4). Therefore, Hamaguchi anticipates Claims 1, 5-9, 18, 21-23, 27-31 and 44.

Claims 1, 5-9, 18, 21-23, 27-31 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto et al. (JP 11-104660 or application number 09-290324). Miyamoto teaches a mixture of hydrogen peroxide and magnesium nitrate to remove odor (See Abstract and machine translation provided). Therefore, Miyamoto anticipates Claims 1, 5-9, 18, 21-23, 27-31 and 44.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

> the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamaguchi in combination with Sine et al. (US 6183766). The teachings of Hamaguchi are discussed above. Hamaguchi does not expressly teach that the oxide is calcium oxide.

Sine teaches that calcium oxide is a known odor controlling agent (Claim 12).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to substitute one oxidizing agent for another when both are known to treat odors.

One of ordinary skill in the art would have been motivated to do this to provide the most effective odor controlling composition for the odor to be eliminated and one would be motivated to substitute one agent for another due to the expense of each agent.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 3, 11, 12, 15, 25, 33, 34, 37, 39, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamaguchi in combination with Frismark et al (US 6703010). The teachings of Hamaguchi are discussed above. Hamaguchi does not expressly teach that the oxide is zinc oxide.

Frismark teaches that zinc oxide is a known odor controlling agent to be used to treat sewage water and waste (Col. 7, lines 32-46; Col. 24, lines 6-30, 50-56).

Neither reference teaches the exact concentrations but the ranges do overlap. With respect to the claimed concentrations, absent a clear showing of criticality, the determination of particular concentrations is within the skill of the ordinary worker as part of the process of normal optimization.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to substitute one oxidizing agent for another when both are known to treat odors in sewage.

One of ordinary skill in the art would have been motivated to do this to provide the most effective odor controlling composition for the odor to be eliminated and one would be motivated to substitute one agent for another due to the expense of each agent.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 4, 13, 14, 16, 17, 26, 35, 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamaguchi in combination with Stone (US 5948269). The

teachings of Hamaguchi are discussed above. Hamaguchi does not expressly teach that the oxide is iron oxide.

Stone teaches that iron oxide is a known odor controlling agent to be used to treat sewage water and waste (Claims 1-3).

Neither reference teaches the exact concentrations but the ranges do overlap. With respect to the claimed concentrations, absent a clear showing of criticality, the determination of particular concentrations is within the skill of the ordinary worker as part of the process of normal optimization.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to substitute one oxidizing agent for another when both are known to treat odors in sewage.

One of ordinary skill in the art would have been motivated to do this to provide the most effective odor controlling composition for the odor to be eliminated and one would be motivated to substitute one agent for another due to the expense of each agent.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Claims 10, 19, 20, 22, 32, 40, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamaguchi et al. The teachings of Hamaguchi are discussed above. Hamaguchi does not expressly teach the exact concentration ranges for the components.

It is the position of the Examiner that absent a clear showing of criticality, the determination of particular concentrations is within the skill of the ordinary worker as part of the process of normal optimization.

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to vary the concentration of the components for eliminating odor.

One of ordinary skill in the art would have been motivated to do this to prepare compositions for various odor controlling applications, i.e., sewage treatment facilities as well as for the home.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Joynes whose telephone number is (571) 272-0597. The examiner can normally be reached on Mon.-Thurs. 8:30 - 6:00, alternate Fri. 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert M. Joynes
Patent Examiner
Art Unit 1615

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600